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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Downey Products, Inc.

Serial No. 76318049

Peter de Jonge of Thorpe, North & Western for Downey
Products, Inc.

Khanh M. Le, Trademark Examining Attorney, Law Office
113 (Odette Bonnet, Managing Attorney).

Before Seeherman, Walters and Rogers, Administrative
Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

Downey Products, Inc. has filed an application to
register on the Principal Register the mark DOWNEY LTD
for "fitted tonneau covers for motor vehicles."¹

¹ Serial No. 76318049, filed September 20, 2001, based on an
allegation of a bona fide intention to use the mark in commerce.

Applicant submitted a disclaimer of LTD apart from the mark as a whole.²

The Trademark Examining Attorney has issued a final refusal to register, under Section 2(e)(4) of the Trademark Act, 15 USC §1052(e)(4), on the basis that applicant's mark is primarily merely a surname.

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested. We affirm the refusal to register.

Whether a term is primarily merely a surname depends on the primary significance of the term to the purchasing public. *In re Harris-Intertype Corp.*, 518 F.2d 629, 186 USPQ 238 (CCPA 1975); and *In re Champion International Corp.*, 229 USPQ 550 (TTAB 1985). The Examining Attorney bears the burden of establishing a *prima facie* case in support of the conclusion that the primary significance of the term to the purchasing public would be that of a surname. If a *prima facie* case is presented, then the burden of rebutting that showing shifts to the applicant. *In re Etablissements Darty et Fils*, 759 F.2d 15, 225 USPQ 652 (Fed. Cir.

² This disclaimer was submitted by applicant, but not expressly accepted by the Examining Attorney. However, we consider the disclaimer to be part of the record.

1985); *In re Harris-Intertype Corp.*, *supra*; *In re Pyro-Spectaculars, Inc.*, 62 USPQ2d 355 (TTAB 2002); and *In re Rebo High Definition Studio Inc.*, 15 USPQ2d 1314 (TTAB 1990).

The Examining Attorney contends that the primary significance of DOWNEY is as a surname; that LTD indicates the form of a business organization and does not have trademark significance; that the addition of LTD to DOWNEY does not change the surname significance of the DOWNEY portion of the mark; and that DOWNEY LTD is likely to be perceived as primarily merely a surname. In support of this position, the Examining Attorney submitted an excerpt from the ReferenceUSA database containing listings of individuals from several states in the United States with "Downey" as a surname and stating that the database contains 16,675 such listings. The Examining Attorney also submitted a sampling of articles retrieved from the LEXIS/NEXIS database referring to numerous different persons, each with the surname "Downey" (the LEXIS/NEXIS search results for "Downey" returned 99,266 stories). Additionally, we take judicial notice of the dictionary definition submitted with the Examining Attorney's brief of "ltd" or "Ltd" as "*abbreviation*."

1. Limited. 2. Limited company,"³ and of a page from *Merriam-Webster's Collegiate Dictionary* (3rd ed. 1998) showing no entry for the term "downey."

In its brief (p. 2), applicant "acknowledges that the term 'Downey' is used as a surname," but contends that it is rare, and that DOWNEY LTD is not primarily merely a surname. Applicant states that the population of the United States is "over 286 million"; that the more than 16,000 residential listings for the surname "Downey" comprise "less than .006%" of the population; and, thus, that "'Downey' is a rare and unusual surname and it will not be recognized as such by the general purchasing public." (Brief, p. 3.) Applicant alleges, further, that because "Downey" does not appear in applicant's mark preceded by initials or a given name, it will not be perceived as primarily merely a surname. Applicant submitted copies of nine third-party registrations and one third-party application for composite marks containing the term DOWNEY; and copies of two applications filed by applicant (which applications have matured into Registration No. 2,792,211 for DOWNEY SE, and Registration No. 2,795,526 for DOWNEY SST, both for

³ *Microsoft Bookshelf Basics - Dictionary.*

the same goods involved herein). Applicant argues that the third-party registrations and application and applicant's registrations are evidence that "Downey" is not primarily merely a surname.

We note that among the factors to be considered in determining whether a term is primarily merely a surname are (i) the rarity of use of the term as a surname; (ii) whether anyone connected with applicant has the surname in question; (iii) whether the term in question has any recognized meaning other than that of a surname; and (iv) whether the term has the "look and sound" of a surname. *In re Benthin Management GmbH*, 37 USPQ2d 1332 (TTAB 1995). *See also In re Gregory*, Application Serial No. 76277664 (TTAB May 12, 2004).

As noted herein, applicant has conceded that "Downey" is a surname. Additionally, we note the more than 16,000 phone listings for individuals with the surname of "Downey." While the number of listings in the ReferenceUSA database for "Downey" may be small compared to the population of the United States as a whole, it is not an insignificant number. On this point, the Board in *In re Gregory*, Application Serial No. 76277664 (TTAB May 12, 2004), recently made the following statement:

We conclude that the question whether a surname is or is not rare is not to be determined solely by comparing the number of listings of the name to the total number of listings in a vast computerized database. Given the large number of different surnames in the United States, even the most common surnames would represent but small fractions of such a database.

We conclude that the number of references in the aforementioned listings establish that "Downey" is not a rare surname; and we note that applicant has provided no evidence that would warrant a different conclusion with respect to this factor.

We now consider whether consumers will view "Downey" only as a surname, or will find it to have some other significance. As noted, there are a substantial number of references in the LEXIS/NEXIS media excerpts to individuals with the surname of "Downey," which supports the conclusion the public has had substantial exposure to "Downey" as a surname and, thus, that it would be perceived by the public as a surname.

Additionally, the Examining Attorney submitted an excerpt from a dictionary showing that there is no listing for "downey," which indicates that the word does not have another commonly-understood meaning.

We also find that "Downey" has the look and feel of a surname. It would not be perceived as an initialism or acronym, see *In re Sava Research Corp.*, 32 USPQ2d 1380 (TTAB 1994), and it does not have the appearance of having been coined. Rather, "Downey" appears to be a cohesive term with no meaning other than as a surname.

However, as in *Benthin, supra*, our inquiry does not end here because the mark at issue is DOWNEY LTD. We must consider whether the composite mark is sufficiently distinctive to create a separate non-surname impression. We conclude that it is not. DOWNEY is the first and most prominent word in the mark; and the additional word LTD is merely an entity designation and does not take away from, or otherwise change, the surname significance of DOWNEY. See, *In re I. Lewis Cigar Mfg. Co.*, 205 F.2d 204, 98 USPQ 265 (CCPA 1953) [S. SEIDENBERG & CO.'S is primarily merely a surname].

We conclude that the Examining Attorney has established a *prima facie* case, un rebutted by applicant, that DOWNEY LTD is primarily merely a surname. We are not persuaded otherwise by the third-party registrations in the record or by applicant's argument that its two other applications for marks containing the term DOWNEY were registered. Those cases are not before us and we must

consider each case on its merits. *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) ["Even if some prior registrations had some characteristics similar to [applicant's application], the PTO's allowance of such prior registrations does not bind the Board or this court."].

Decision: The refusal of registration under Section 2(e)(4) of the Act, on the ground that DOWNEY LTD is primarily merely a surname, is affirmed.